

FIG. 7

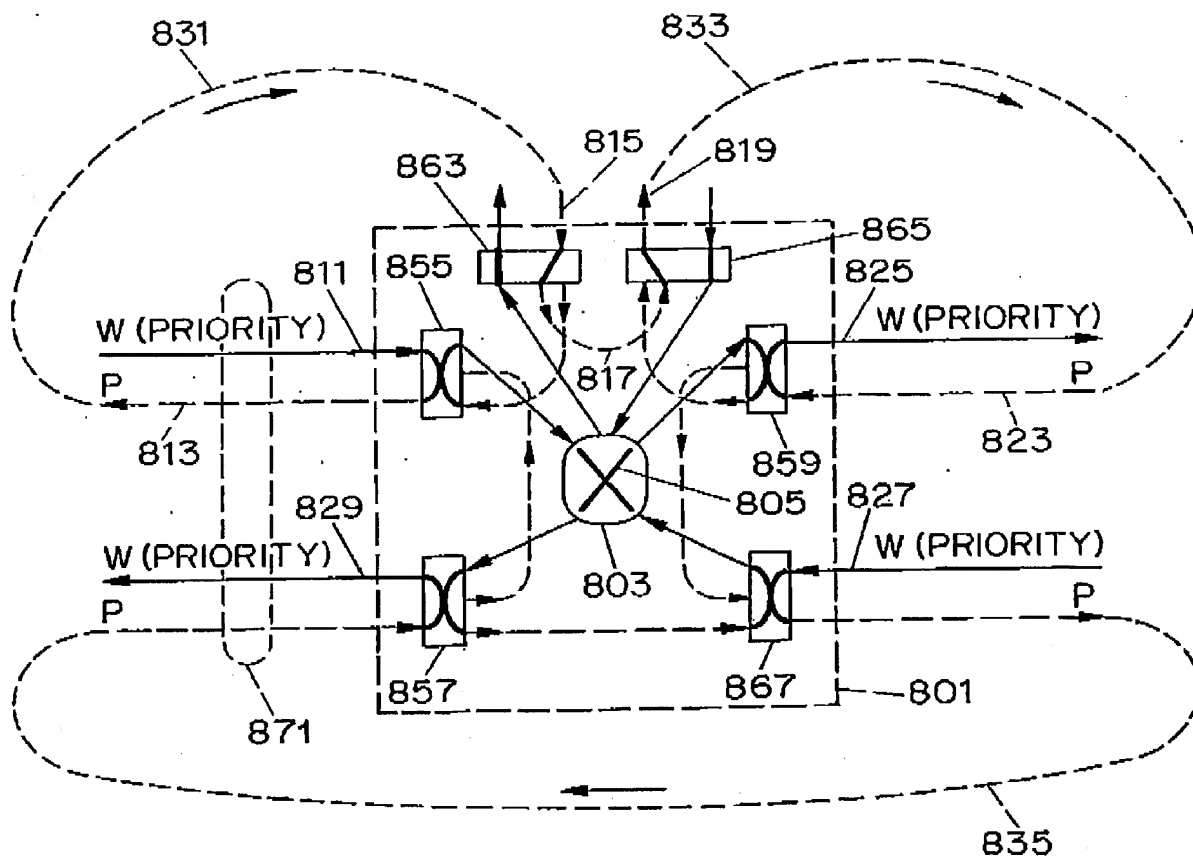


FIG. 8

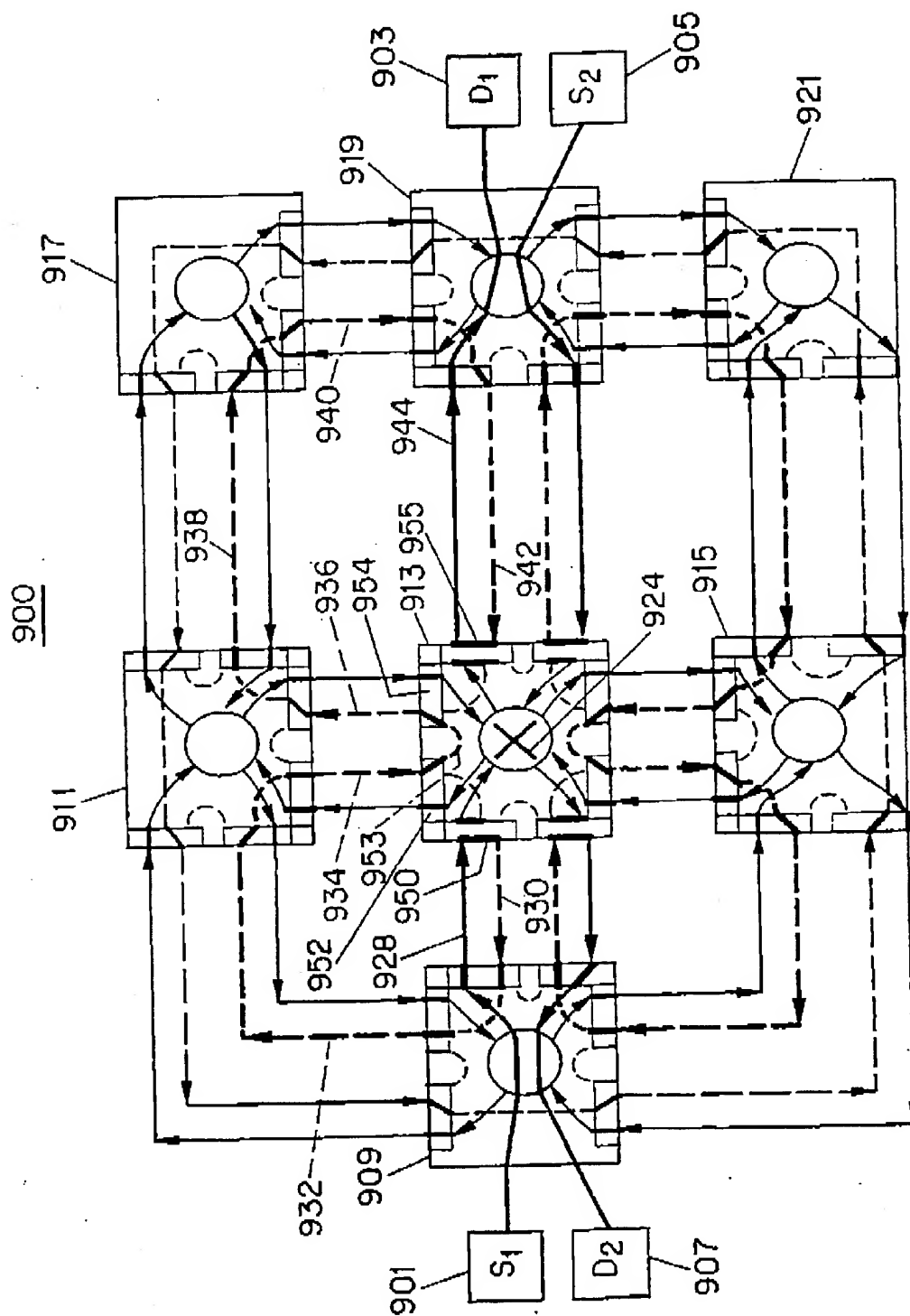


FIG. 9

9/9

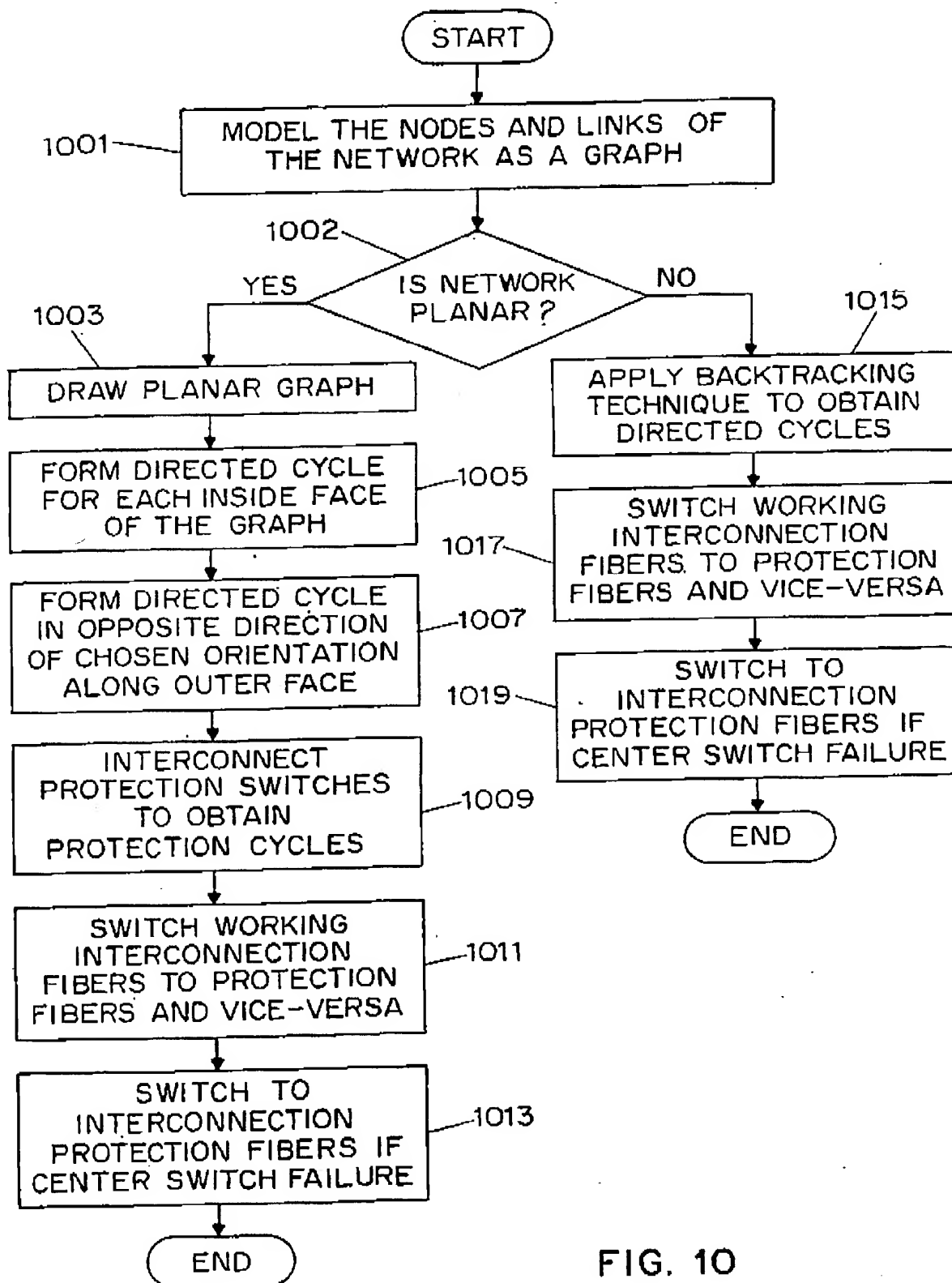


FIG. 10

SUBSTITUTE SHEET (RULE 26)

unlawful taking prohibited by the U.S. Constitution, 5<sup>th</sup> Amendment. This is necessarily so as the following example will illustrate:

**Example**

The Examiner stated that Species (1) is Figures 1, 2, 3A, 14, 15 and Species (7) is Figure 4, 5, 6. As required under M.P.E.P. §818.03(b), Applicant provisionally elected, with traverse, to pursue Species (1). Applicant's claims 1-25 (as well as other claims) reads on Figures 1, 2, 3A, 14, and 15. Let us assume that Applicant obtains allowance of Claims 1-25 and then wishes to file a divisional application concerning the Species (7). However, Claims 1-25 also reads on Figure 4, 5, 6. Accordingly, Applicant could not file a divisional application and obtain claims to cover the embodiment of Figures 4, 5, 6 because Claims 1-25 will not be allowed in a divisional application since the identical claim is in the parent patent. Thus, in this example, by being required to exclude the subject matter of non-species 1 embodiments in the first patent application, Applicant's rights to their Fig. 4, 5, 6 embodiment will have been extinguished and taken by the government.

3) The purported restriction into 9 species is inconsistent with the specification as submitted.

Fig. 1 is a side view of a first embodiment of a system for delivering hemostasis promoting material to a blood vessel puncture site.

Fig. 2 is an assembled view of Fig. 1

Figs. 3A-3G are side views of alternative embodiments of Fig. 2

Fig. 4 is a side view of a second embodiment of a system for delivering hemostasis promoting material to a blood vessel puncture site.

Figs. 5-6 are additional views of Fig. 4

Fig. 7 is a side view of a third embodiment of a system for delivering hemostasis promoting material to a blood vessel puncture site.

Figs. 8-9 are additional views of Fig. 7

Fig. 10 is a side view of a fourth embodiment of a system for delivering hemostasis promoting material to a blood vessel puncture site.

Figs. 11-13 are additional views of Fig. 10.

Figs. 14-15 are additional views of Fig. 1

Figs. 16-21 illustrate views to deliver the hemostasis promoting material to the blood vessel puncture site.

- 4) As illustrated in Table I (which sets forth the 6 pending independent claims together with at least some corresponding figures believed read upon by those claims) the statements made in the restriction requirement are clearly unsupportable and are wrong. Table II shows that the various "species" identified by the Examiner, each corresponding with numerous independent claims.

TABLE I

INDEPENDENT CLAIM	READS ON AT LEAST THESE FIGURES
1	1, 2, 3A, 3B, 3C, 3D, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15
13	1, 2, 3A, 3B, 3C, 3D, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15
16	1, 2, 3A, 3B, 3C, 3D, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15
20	14, 15, 16, 17, 18, 19, 20, 21
23	1, 2, 3A, 3B, 3C, 3D, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21
26	1, 2, 3A, 3B, 3E, 3F, 3G, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15

TABLE 2

"SPECIES"	CORRESPONDING FIGURES	CORRESPONDING INDEPENDENT CLAIMS
-----------	-----------------------	----------------------------------

(1)	1, 2, 3A, 14, 15	1, 13, 16, 20, 23, 26
(2)	3B	1, 13, 16, 26
(3)	3C, 3D	1, 13, 16, 26
(4)	3E	26
(5)	3F	26
(6)	3G	26
(7)	4, 5, 6	1, 13, 16, 20, 23, 26
(8)	7, 8, 9	1, 13, 16, 20, 23, 26
(9)	10, 11, 12, 13	1, 13, 16, 20, 23, 26

5) The Manual of Patent Examining Procedure (MPEP) does not allow the restriction requirement imposed by the Examiner in this case. The MPEP requires that an Examiner must base a restriction requirement on the **claims**, not the figures in an application.

The statutory basis for restriction requirements refers to **claims**, not figures. "If two or more independent and distinct inventions are **claimed** in one application, the Director may require the application to be restricted to one of the inventions." 35 U.S.C. §121.

The MPEP clearly requires an Examiner to base a restriction on the **claims**. There are many examples of this throughout Chapter 800, which governs restriction practice, and some of the most prominent are recited below.

"In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence." MPEP § 806.01.

"Where the **claims** of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required." MPEP § 806.03 (Para. 1).

"Where an applicant files a divisional application claiming a species previously **claimed** but not elected in the parent case . . .there should be no determination of whether or not the species **claimed** in the divisional

application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made.” MPEP § 806.04(h) (Para. 1).

“The Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application.” MPEP § 806.04(h) (Para. 2).

The form Outline of Letter for Restriction requires the Examiner to, “List **claims** in each group.” MPEP § 817 Outline of Letter (a)(2).

### **III. Summary**

Accordingly, the pending “restriction requirement” is without merit, ill considered, and violates Applicants’ rights guaranteed under the United States Constitution, 5<sup>th</sup> Amendment<sup>7</sup> and under 35 U.S.C. §§101 and 112(6). Since at least independent claims 1, 13, 16, 26, 20, and 23 read on all 9 “species” identified by Examiner Kennedy, the instant restriction requirement must be withdrawn.

Applicant agrees to a restriction requirement setting forth two groups of claims: Group I: Claims 1-19, 26-28, drawn to an apparatus for delivering hemostasis material, and Group II: Claims 20-25, drawn to a method for promoting hemostasis. In fact, Applicant elected to pursue the claims of Group I and will file a divisional to pursue the claims in Group II.

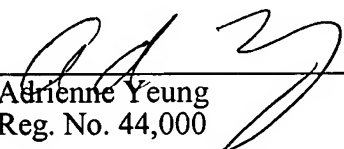
If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account 50-1698.

Application No.: 10/007,204  
Petition From Requirement for Restriction  
Dated April 23, 2004

Docket No.:034298-000124

Respectfully submitted,  
THELEN REID & PRIEST LLP

Dated: April 23, 2004

  
\_\_\_\_\_  
Adrienne Yeung  
Reg. No. 44,000

THELEN REID & PRIEST LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
Tel: (408) 292-5800  
Fax:(408) 287-8040